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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,786	07/28/2005	Marc Rehfeld	263606US6PCT	1962
22850	7590	02/08/2007		
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER ZIRKER, DANIEL R	
			ART UNIT	PAPER NUMBER
			1771	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/08/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/521,786

Applicant(s)

REHFELD ET AL.

Examiner

Daniel Zirker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 33-64 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/21/05</u> . | 6) <input type="checkbox"/> Other: ____ |

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1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 33-64 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, the newly presented claims still contain a significant number of informalisms, vague and indefinite statements and the like. In claims 1 and 61 "two elements" might more desirably be changed to "two substrates" and it appears desirable to more further define the strip than just stating that it is "formed from at least one plastic-based damping material", while in claim 61, line 2 it should be clearly indicated that it is the "strip" which is formed from at least one damping material. Also, it is believed to be desirable to put into these two claims at least some language pertaining to how the two performance parameters of the strip are attained. Claims 46, 47 and 55 should have suitable Markush language, and a significant number of claims 46-60 contain multiple informalisms such as (claim 46) "is are" (line 2), "possibly modified" (lines 3-4), "especially" (line 5), and "or else" (line 5). Additionally, note the presence of such informalisms in these claims as "preferably", "type", and three "and/or" in claim 55. Additionally, claim 56 appears to read upon every conceivable cross section imaginable, and the Examiner finally notes that claim 1 (like claim 61) should use "comprising" language.

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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4. The specification is objected to under 35 USC 112, first paragraph, as failing to contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art to make and use the invention. More particularly, the disclosure, while otherwise believed to be enabling to one of ordinary skill, is believed to be nonenabling regarding the various types and suitable species of "adhesive material", "nondamping adhesive material" and materials "which exhibit adhesion properties". The Examiner believes that the disclosure of such embodiments such as set forth most notably on page 5 (as well as elsewhere) of the specification is so inadequate as to constitute little more than an invitation to experiment.

5. Claims 36-40 and 43-45 are rejected under 35 USC 112, 1st Paragraph, as being based on a nonenabling disclosure.

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 61-64 are rejected under 35 U.S.C. 101 because

the claimed invention is directed to non-statutory subject matter. More particularly these claims are believed to fail the statutory test for 101 patentable subject matter because no physically tangible result is accomplished through exercising the claimed method step(s).

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 33-35, 46, 55-57, 59 and 60 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0 696 523 A1. The reference discloses (note paragraph 3 of the IPER report as well as the Abstract, page 2, lines 3-6 and 44-52, page 5, lines 26-44, Example 2, Example 7 at page 12, line 46-page 13, line 3, Fig 9) a profiled member (Fig 2 and element 26) which is to be inserted between two elements 12 and 16 so as to attenuate sounds traveling through one of the elements (page 2, lines 44-49), the profiled member formed from a plastic based damping material (e.g. page 11, lines 11-12). As can be seen from Fig. 9 at graph 102 (note also page 12, line 56) the profiled member has a loss factor of at least 0.25 at a temperature of about 0 degrees C. At this temperature the modulus of elasticity is 100 MPa (see graph 100 of Fig 9, and page 12, line 56), which corresponds to an equivalent actual stiffness per unit length of about 100 MPa, because the width and thickness of the profiled member have approximately the same value (see page 5, lines 26-33). Note also that with respect to claims 35, 46, 55, 56, and 59 the profiled member is suitable for use in a vehicle (page 2, line 3) which is made of a single damping thermoplastic elastomeric material applied onto one of the "elements" by injection molding (page 11, lines 11-12), and that the section is even over its length (Fig 2, element 26).

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 36-45, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP '523 taken individually, or for claims 36-45 in view of JP 63 192608 Patent Abstract. The primary reference is again relied upon as set forth, above, while JP '608 discloses (Fig 2) an arrangement of damping materials 3 and 4 in juxtapositioned arrangements with adhesive 5 in a damping strip 2, which can also contain an air gap. As such, the Examiner believes that one of ordinary skill would conclude that a wide variety of arrangements of the damping materials, nondamping adhesive materials, damping materials which possess adhesive materials and the like are suitable for use in the claimed genus of "strips". It is further believed that one of ordinary skill would have ample motivation to combine the two references by incorporating the embodiments of JP '608 into the acoustic damping strip of the primary reference, as each reference is taken from the identical art, and faces the same sound damping problems in identical structures. Finally, with respect to those parameters that are not either expressly or inherently disclosed, one of ordinary skill would find these to each be obvious modifications thereof, in the absence of unexpected results.

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 33-36, 46,47, 55-57, 59 and 60 are rejected under 35 U.S.C. 102(a or e) as being anticipated by Johnson et al, US 2001/0051260 A1. Note particularly the Abstract, Paragraphs 0024, 0027, 0047, 0049-0052, 0059-0062, 0066, 0102-0108, 0125. The reference discloses, in certain embodiments, a genus of multilayer articles suitable for sealing two substrates together, particularly where one of them is automotible glass that can include a core layer 14 which can act (0052) as an internal vibration damper to minimize noise associated with variable frequency substrate movement once the two substrates have been sealed together. Suitable core layers can include (0062) polyacrylates and thermoplastic materials such as ethylene vinyl acetate copolymers. Additionally, multiple other layers such as bonding layer 16 (0102-0108) can be disposed between core layer 14 and one of the substrates. Accordingly, the Examiner believes that the resulting genus of acoustic damping strips would inherently possess the two performance parameters found in claim 33 (and also dependent claims 34 and 45) since their various elements are made from materials taught as suitable by applicants' specification.

13. Claims 37-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson et al, taken either individually or in view of JP Abst '608. The primary reference is again relied upon substantially as set forth, above, and with respect to the remaining claims, whether rejected either individually in view of the primary reference or

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in view of JP '608 Abst. the analysis is very similar to that set forth previously, with the "608 Abst. again being relied upon for disclosing in particular the multiple arrangements of damping materials, adhesive materials and the like to either disclose or render obvious the various claimed genres of articles.

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note also a machine translation of the Claims and Detailed Description of JP 2000-272936, and Niwa et al, both cited in the IPER Report.

15. Claims 48-54, 58 and 61-64 are not rejected on the basis of adverse prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is 571-272-1486. The examiner can normally be reached on Monday - Thursday from 8:30 to 6:00. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on 571 - 272 - 1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Daniel Zirker
Primary Examiner
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A handwritten signature in black ink that reads "Daniel Zirker". The signature is written in a cursive style with a large, stylized 'Z'.